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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,283	09/28/2001	James Morrow	10407/521	6806

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EXAMINER

CHERUBIN, YVESTE GILBERTE

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/967,283	Applicant(s) MORROW ET AL.	
	Examiner Yveste G. Cherubin	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,30-46,48-50 and 57-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,30-46,48-50 and 57-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some.* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/19/04, 3/16/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the RCE of the US Application No. 09/967,283 filed July 19, 2004. Claims 1-20, 30-46, 48-50, 57-59 are pending.

Claim Rejections - 35 USC § 112

2. Claims 8, and 46 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the term "stand alone and remote", does not reasonably provide enablement for a stand alone gaming device being remotely reconfigured. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Stand-alone device, by definition, pertains to device that does not require support from another device or system, such as a network. Claim 8 recites "a plurality of screens that display video content for a game of chance located on a stand-alone gaming machine, wherein all of the video content for a different game of chance is remotely reconfigurable". Noting the definition above, it is unclear as to how a stand-alone system is capable of remotely being reconfigured. Clarification is required. The term remote is a broad term that can pertain to a lot of different meanings. It may pertain to another location such as room, building, city.

The same notation applies to claim 46.

For the purpose of this action, it has been assumed that the system was intended to be a stand-alone system.

Art Unit: 3713

Claims 9-20 are being rejected as being dependent upon rejected claim 8.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, 30-46, 48-50, 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedrick (of record) in view of Giobbi (of record) and further in view of Marnell (US Patent No. 5,393,057).

Regarding claims 1-2, 4, 6-7, 14-15, 17, 19-20, 30, 38-40, 42, 44, 46, 49-50, 57-58 Hedrick discloses a gaming machine including a plurality of displays/screens displaying video content for a game of chance, see abstract. Hedrick further discloses his gaming machine capable of being easily modified/reconfigured with new games or features, 2:62-66. However, Hedrick is silent on the automatic reconfiguration happening in response to a trigger. Giobbi teaches a gaming system in which video content is capable of being reconfigured in response to various triggers such as time, pages 5-6, section [0050], play frequency, page 6, section [0050], wagered amount, page 5, section [0041, 0050], player request, page 2, section [0021], lines 20-25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the feature cited above as taught by Giobbi into the Hedrick type system in

order to provide automatic operation of subsequent gaming sessions, which would attract players. Hedrick nor Giobbi disclose using a stand-alone system. Marnell discloses a system capable of providing a primary and secondary gaming system and wherein the secondary game is a different game of chance from the primary game of chance. Marnell further teaches using the capability of using stand-alone device to carry out the process in its system, 9-42-48. It would have obvious to one of ordinary skill in the art at the time the invention was made in order to enable use of the system without having to rely on some type of network communication interface.

Regarding claim 5, 18, 43 Giobbi discloses allowing casino operators to reconfigure screen that display video content of game of chance, pages 5-6, section [0050]

Regarding claims 8-9, Giobbi discloses a networked/centralized gaming system with modifiable remote display terminals, see title, page 1, section [0001], lines 1-3, page 5, section [0040]. Giobbi further discloses his terminals comprising a plurality of displays (24a, 24b), page 5, section [0043].

Regarding claim 10, Giobbi discloses the content of one of the screens/displays comprising the video content of an entire different game, page 5, section [0043].

Regarding claim 11, Giobbi discloses a screen/display displaying a game being played by a player, page 5, section [0043] and further discloses a pay table capable of being accessed/displayed via a button, page 4, section [0036].

Regarding claim 13, Giobbi discloses a primary screen/display displaying a game being played by a player and a secondary screen/display displaying a secondary game play features, page 5, section [0043].

Art Unit: 3713

Regarding claim 45, refer to claims 1 and 7 above for rejection.

Regarding claim 5, Giobbi discloses the claimed invention as substantially as shown above. Giobbi further discloses a processor running the game and further discloses using local stored video content to provide reconfiguration to screens that display video content, page 6, section [0057].

Regarding claim 58, refer to claims 1 and 57 for rejection.

Regarding claims 12, 48, Hedrick is cited to teach a plurality of displays, see abstract. Adding a third display to display artwork associated to the game would have been an obvious matter of design choice. This modification would have been obvious because one of ordinary skill in the art would have been motivated to do so in order to provide more information related to the game being played.

Regarding claim 31, it recites the automatic reconfiguration already rejected above in claim 7, therefore refer to claim 7 above for rejection. As per claim 32, refer to claim 2 above for rejection.

Regarding claims 3, 16, 33, 41, 59, Hedrick discloses the use of player tracking system to identify players, 6:25-34.

Regarding claim 34, refer to claim 4 above for rejection.

Regarding claim 35, refer to claim 5 above for rejection.

Regarding claim 36, refer to claim 6 above for rejection.

Regarding claim 37, refer to claim 7 above for rejection.

Response to Arguments

4. Applicant's arguments with respect to claims 1-20, 30-46, 48-50, 57-59 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Xuan can be reached on (703) 308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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TC3700